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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,932	10/30/2003	James F. McGuckin JR.	1255	1044

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EXAMINER

SHAFFER, RICHARD R

ART UNIT PAPER NUMBER

3733

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/696,932	<b>Applicant(s)</b> MCGUCKIN ET AL.	
	<b>Examiner</b> Richard R. Shaffer	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/8/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to because they fail formal requirements. Please see the attached Draftsperson Drawing Review Sheet for guidance to correct the noted deficiencies. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Double Patenting***

Claims 1-9 and 11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 11/219,432, claims 1-25 of copending Application No.

Art Unit: 3733

10/805,796, claims 1-18 of copending Application No. 10/919,825, claims 32-49 of copending Application No. 10/638,846, and claims 1-23 of copending Application No. 10/697,211. Although the conflicting claims are not identical, they are not patentably distinct from each other because they merely recite more structure and are thus a "species" of the current "generic" claimed invention. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-9 and 11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,783,538 as well as claims 1-29 of U.S. Patent No. 6,793,665. Although the conflicting claims are not identical, they are not patentably distinct from each other because they merely recite more structure and are thus a "species" of the current "generic" claimed invention. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the first mounting" in line 15. There is insufficient antecedent basis for this limitation in the claim. The depending claims have also been rejected due to being dependent upon an indefinite base claim.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. Applicant asserts in the preamble of claim 18 that it is a method of "implanting a vessel filter." However, as soon as the filter is implanted, applicant supposedly removes the filter with the limitation "removing the implanted vessel filter from the patient's body." This would cause damage to the surrounding vessels without a step preceding it. It appears to the examiner that applicant actually intended to claim "removing the tubular delivery member" instead. Therefore, the claim is also indefinite because the preamble does not accurately describe the method as understood in light of the specification. For examination purposes, it will be treated as reciting "removing the tubular delivery member."

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3733

Claims 1-4, 6, 7, 9, 11-14, 16, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by van der Burg et al (US Patent 6,994,092).

Van der Burg et al disclose a device (**Figure 35**) comprising: a mounting section (straight portion of **220**) having a proximal and distal end; two filtering sections defined by the two spring regions (**17, 218**) found at either end (**190, 192**); the filtering sections created from a plurality of longitudinal struts (**220**) curved radially inward as well as fully capable of being placed axially inward when using the string pull expansion method shown in **Figure 33**; the struts are spaced circumferentially about 60 degrees apart (inherent from 6 equally spaced struts about a circle); a plurality of vessel engaging members (**195**); the device is made of Nitinol (**Column 12, Lines 52-60**); and the struts having a varying width along their length as easily shown in **Figure 30A** due to the branching of the vessel engaging members (**195**). In regard to claim 18, see **Column 16, Line 51 through Column 18, Line 50**.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over van der Burg et al in view of Bosma et al (US Patent 6,443,972).

Van der Burg et al disclose all of the claimed limitations except is silent as to whether the longitudinal struts are roughened. Bosma et al teach (**Column 6, Lines 52-**

Art Unit: 3733

53) that simply coarsening the outer surface of the device can improve the retention of the device within a blood vessel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of van der Burg et al with a roughened outer surface as taught by Bosma et al in order to improve atraumatic retention within a blood vessel.

Claims 8, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over van der Burg et al in view of Gilson et al (US Patent Application Publication 2002/0058911).

Van der Burg et al disclose all of the claimed limitations except for struts out of phase as well as connecting ribs to adjacent longitudinal struts. Gilson et al teach in **Figures 15-22** out of phase struts and in **Figures 23-26** connecting ribs between struts. Within the specification, Gilson et al consider these structures mere embodiments and all function essentially the same with only the process of manufacture differing. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to also manufacture the device of Van der Burg et al with out-of-phase struts or interconnected struts given the preference or ease of manufacture.

### ***Response to Arguments***

Applicant's arguments filed May 8<sup>th</sup>, 2006 have been fully considered but they are not persuasive. Applicant alleges first that the device of van der Burg et al does not have proximal most and distal most filter points further toward the center than the distal most and proximal most points of the mounting section. As described in the current Office Action, the points are moveable and are inherently capable of being placed in the

Art Unit: 3733

claimed position. Secondly, applicant alleges that the device is an occlusion device, not a filter. In the disclosure, the half or full outer covering (15) is optional. Without it, it would perform as claimed. When also considering the broadest reasonable interpretation, an occlusion device is intended to ideally filter out everything.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard R. Shaffer whose telephone number is 571-272-8683. The examiner can normally be reached on Monday-Friday (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Richard Shaffer  
July 30<sup>th</sup>, 2006



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER